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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BOAZ CARMELI, JOHN J. DUIGENAN,
GIDON GERSHINSKY, STEPHEN J. TODD,
and GRAHAM D. WALLIS

Appeal 2009-008813
Application 10/713,956
Technology Center 2100

Before HOWARD B. BLANKENSHIP, ST. JOHN COURTENAY III, and DEBRA K. STEPHENS, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON APPEAL[1]

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-32, 36-51, 53, and 54, which are all the claims remaining in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse, and enter a new ground of rejection as permitted by 37 C.F.R. § 41.50(b).

Representative Claim

> 17. A method for liveness monitoring in a publish/subscribe messaging system having at least one broker and at least one subscriber, the method comprising:
>
> sending a status request message from the at least one broker to the at least one subscriber,
>
> responsive to each subscriber receiving the status request message from the at least one broker, setting a timer for each subscriber of the at least one subscriber, and
>
> responsive to the timer expiring, sending a multicast message claiming response to the at least one broker from a particular subscriber of the at least one subscriber.

Prior Art

> Qixiang Sun, *Reliable Multicast for Publish/Subscribe Systems* (Master's thesis), Massachusetts Institute of Technology (May 2000) ("Sun").

Examiner's Rejection

Claims 1-32, 36-51, 53, and 54 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Sun.

DISCUSSION

New Ground of Rejection -- 35 U.S.C. § 112, Second Paragraph

We reject claims 1-32, 36-51, 53, and 54 under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claim 17 is representative of all the pending independent claims with respect to this rejection. The claim recites setting a timer for each subscriber of the at least one subscriber, and responsive to "the timer" expiring, sending a multicast message. "[T]he timer" lacks proper antecedent basis in the claim, because the claim specifies that "a timer" is set for "each subscriber" of the "at least one subscriber."

Although claim 17 recites "at least one subscriber," the claim does not appear to cover the trivial case of only "one" subscriber, as the claim later specifies "a particular subscriber of the at least one subscriber" -- i.e., the language refers to at least two separate subscribers. In any event, a single timer for multiple subscribers, as claimed, is inconsistent with the description of the invention as set forth in Figure 3 and at pages 12 and 13 of the Specification. Where two or more timers are set, "the timer" recitation of claim 17 does not specify which of the multiple timers are expiring.

We are thus unable to ascertain the metes and bounds of the subject matter encompassed by each of the independent claims (1, 17, 36, and 44).

The Rejection Over Prior Art

In response to the § 102(b) rejection, Appellants argue claim 17 as representative of all the independent claims.

At the outset, we note that claim 17, as drafted, is indefinite. We have set forth a new ground of rejection under 35 U.S.C. § 112, second paragraph,

supra. For the sole purpose of comparing the claimed subject matter with the applied prior art in our review of the Examiner's rejection, we will presume that claim 17 requires sending a multicast message claiming response to the at least one broker from a particular subscriber of the at least one subscriber in response to a first of the set timers expiring. *See* Spec. 12-13; Fig. 3.

Sun describes a hybrid system for reliable multicasting comprised of a Logger based recovery (at 22-31; Fig. 3.1) and a Gossip based recovery (at 32-43; Fig. 4.1). The statement of the rejection (Ans. 3-4) applied against the independent claims refers to the Logger based recovery system of Figure 3.1. In response to Appellants' challenge that the cited material fails to meet the terms of representative claim 17 (Ans. 10-17), the Examiner does not explain how the originally cited material does so, but instead cites Sun's description of the Gossip based recovery system as depicted in Figure 4.1.

In any event, the rejection is unclear in mapping the elements recited in claim 17 to the structures described by Sun. For example, the statement of the rejection (Ans. 3) seems to correlate Sun's Logger with the claimed "at least one broker." However, the rejection also seems to allege that the Logger performs the action of periodically sending a heartbeat message. The heartbeat message in Sun is not sent by the Logger, but by the Sender Module, as the reference describes at page 23. We decline to speculate on which structure or structures in the reference the rejection deems to correspond to the claimed elements.

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." *Lindemann Maschinenfabrik GMBH v. American Hoist &*

Derrick Co., 730 F.2d 1452, 1458 (Fed. Cir. 1984). We agree with Appellants to the extent that the rejection applied against the independent claims (1, 17, 36, and 44) does not set forth a prima facie case of unpatentability under 35 U.S.C. § 102. Accordingly, we cannot sustain the rejection of any claim on appeal on the basis of anticipation.

DECISION

The rejection of claims 1-32, 36-51, 53, and 54 under 35 U.S.C. § 102(b) as being anticipated by Sun is reversed.

In a new ground of rejection, we have rejected claims 1-32, 36-51, 53, and 54 under 35 U.S.C. § 112, second paragraph, as being indefinite.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (2010). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

> (1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .
>
> (2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 41.50(f).

REVERSED-- 37 C.F.R. § 41.50(b)

msc

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